

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claims 1 and 11 are amended to remove the feature that the intaglio printing extends over the recess having the integrated circuit therein, and to incorporate the features of previous claim 10, as well as to clarify that the adhesive strengths of the self adhesive covering element and of the bond between the integrated circuit and the antenna are adjusted relative to each other such that a removal of the security label from the data carrier results in damaging the antenna or separating the antenna from the integrated circuit. It is respectfully submitted that no new matter is added, since the change merely removes features and merges the subject matter of previously presented claims, and support for the amendments may be found, for example, at least in paragraphs [0010], [0012], [0021], [0029], [0041], and [0047] of the accompanying description in the specification as originally filed.

Claim 10 is canceled and the features thereof added to amended claims 1 and 11.

Claims 2, 5, and 14 remain canceled.

Claims 3, 4, 6-9, 12, 13, and 15-18 are left unchanged.

New claims 19 and 20 are substantially similar to amended claims 1 and 11, while referring to the cold adhesive layer instead of the covering element. It is respectfully submitted that no new matter is added since support for new claims 19 and 20 can be found in original claims 1, 10, and 11, and support for the new claims may be found, for example, at least in paragraphs [0010], [0012], [0021], [0029], [0041], and [0047] of the accompanying description in the specification as originally filed.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

2. Rejection of claims 1, 3, 4, 6-9, 11, 13, and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and further in view of U.S. patent no. 5,492,370 (*Chatwin et al.*)

This rejection is rendered moot by the inclusion of the subject matter of previous claim 10, which is acknowledged in the paragraph spanning pages 8-9 of the Office action to be missing from the proposed combination of the *Royer*, *Moskowitz*, and *Chatwin* patents, in amended claims 1 and 11, from which the remaining claims 3, 4, 6-9, 13, and 15-18 depend.

Accordingly, a *prima facie* case of obviousness cannot be established with respect to amended claims 1 and 11, from which the remaining claims 3, 4, 6-9, 13, and 15-18 depend, and withdrawal of this rejection is respectfully requested.

The subject matter of previous claim 10 is also included in newly presented claims 19 and 20, and thus, new claims 19 and 20 are also considered to be patentable in view of the proposed combination of the *Royer*, *Moskowitz*, and *Chatwin* patents.

3. Rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) in view of U.S. patent no. 5,492,370 (*Chatwin et al.*) and further in view of U.S. publication no. 2004/0157054 (*Rancien*)

This rejection is rendered moot by the cancellation of claim 10.

Accordingly, withdrawal of this rejection is respectfully requested.

In so far as the rejection may be considered applicable to amended claims 1 and 11, and to new claims 19 and 20, it is respectfully submitted that the submission of the English language translation of the priority document DE 103 16 771.4, along with a

statement that the translation is accurate, renders the *Rancien* publication ineffectual as prior art under 35 U.S.C. § 102(a). Further, since the international application PCT/FR02/01152 which the *Rancien* publication is related to was not published in the English language, the *Rancien* publication has no effective filing date under 35 U.S.C. § 102(e).

Therefore, the *Rancien* publication is not valid prior art with respect to amended claims 1 and 11, and to new claims 19 and 20, and withdrawal of this rejection is respectfully requested.

4. Rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) in view of U.S. patent no. 5,492,370 (*Chatwin et al.*) and further in view of U.S. patent no. 5,763,058 (*Isen et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Isen* patent fails to provide for the deficiencies of the proposed combination of the *Royer*, *Moskowitz*, and *Chatwin* patents, as discussed above in detail with respect to amended claim 11, from which claim 12 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500
Facsimile: (703) 683-1080

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Respectfully submitted,
/Patrick M. Buechner/
PATRICK M. BUECHNER
Attorney for Applicants
Registration No. 57,504